

REMARKS

By this submission, previously pending claims 2, 3, 7, 22 and 23 are amended, and claims 1, 4-6, 8-21 and 25-27 are withdrawn without prejudice. Original claim 24 remains pending. Additionally, new claims 28 and 29 are introduced by this submission.

No new matter is introduced by the now-submitted amendments or new claims.

It is requested in view of the following discussions that the reported restriction and/or election requirements be reconsidered and withdrawn. Alternatively, in view of the submitted claim amendments and the following discussions it is requested that the reported restriction and/or election requirements be reconsidered and not repeated in any further action issued for this application.

ELECTION

In compliance with 35 USC §121, an election here is made to “Species A: Figures 3-4” as listed in the outstanding action. To implement this election, claims 1, 4-6, 8-21 and 25-27 have been withdrawn without prejudice. Further, in compliance with this election, new claim 28 now is submitted. This new claim 28 recites the subject matter of now withdrawn claim 1 with the further limitations that the “outer element” is a “bioabsorbable stent” and the “inner element” is a “self-expanding metal stent.” In further compliance with the election, original dependent 2, 3, 7 and 22 are amended to now be dependent from new claim 28. Original claim 23 is believed to be in compliance with the election, but now is amended to recite “a” body lumen in line 4 to provide an antecedent basis for recitation of “the body lumen” in the last line of that claim. Claim 23 is further amended to clarify specific recited “stent” structures. Finally, new claim 29 now is submitted. This new claim 29 includes the substantive recitations of now withdrawn claim 25 and the further limitations of the “inner element” being a “self-expanding metal” and the “outer element” being made of a “bioabsorbable material”. Again, this new claim is believed to be in compliance with the election set out here.

Restriction Requirement Traversal

The reported restrictions are traversed.

The reported reasons for insisting upon the restrictions are set out in a single sentence in the action. Specifically, this sentence states that: “The species are independent or distinct because they pertain to divergent subject matter.” No further explanation is provided in the action. MPEP §808 directs:

Every requirement to restrict has two aspects: (A) The reasons (as distinguished from the mere statement of conclusion) why each invention *as claimed* is either independent or distinct from the other(s); and (B) reasons why there would be a serious burden on the examiner if the restriction is not required (Emphasis added).

Indisputably the issued action fails to provide “reasons” and merely makes a statement of conclusion. Further, the action does not address the claims in the application, but lists as the separate inventions, i.e., species, the figures in the original filed application. Again, it is indisputable that the action fails to identify “reasons why there would be a serious burden on the examiner if restriction is not required”.

The subject matter of the disclosed and claimed invention here is a combined stent structure. In this context it is submitted that the filed application raises no issues as to independent inventions, nor do the original filed claims raise a matter of distinct claiming for related inventions. In fact, it is submitted that here related inventions are not distinctly claimed. Therefore, in accordance with MPEP 806(C) that directs “[w]here intentions are related as disclosed but are not distinct or claimed, restriction is never proper”.

Accordingly, it is requested that the reported restrictions be withdrawn.

In the alternative, if the reported restrictions are not withdrawn, it is requested that now withdrawn claims be rejoined if any of the pending corresponding claims are found allowable and generic.

CONCLUSION

It is submitted that the above discussions directed to why the reported restriction/election requirements are traversed overcomes these requirements and as such the requirements should be withdrawn.

Alternatively, in light of the now submitted election of identified "Species A", the claim amendments, withdrawal of claims, new claim submissions and above discussions, it is believed that all reported restriction and/or election requirements have been addressed. Should the examiner have any question, request or suggestion, he is invited to contact the undersigned attorney at the telephone number indicated below.

Applicant believes no additional fee beyond the submitted \$500.00 for excess claims is due with this response. However, if any further fee is due, please charge our Deposit Account No. 06-2375, under Order No. WO-BSX 228/10207709 from which the undersigned is authorized to draw.

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Respectfully submitted,

By


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